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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/771,871	02/04/2004	Joseph W. Picczynski II	ZIM0586	3761

43963 7590 10/01/2007  
ZIMMER TECHNOLOGY - BAKER & DANIELS  
111 EAST WAYNE STREET, SUITE 800  
FORT WAYNE, IN 46802

EXAMINER
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WOODALL, NICHOLAS W

ART UNIT	PAPER NUMBER
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3733

MAIL DATE	DELIVERY MODE
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10/01/2007

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

Application No.

10/771,871

Applicant(s)

PIECZYNSKI ET AL.

Examiner

Nicholas Woodall

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 06 July 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 24-26, 33-45, 52 and 56-59 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 34-45 is/are allowed.
- 6) ☒ Claim(s) 24-26, 33, 52 and 56-59 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 06 July 2007 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- ☐ Notice of Informal Patent Application
- ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

1. This action is in response to applicant's amendment received on 07/06/2007.

#### ***Allowable Subject Matter***

2. The indicated allowability of claims 24-26, 33, 52, and 56-59 is withdrawn in view of the reference(s) to Burkinshaw. Rejections based on the cited reference(s) follow.

#### ***Drawings***

3. The drawings were received on 07/06/2007. These drawings are acceptable.

#### ***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 24-26, 33, 52, and 56-59 are rejected under 35 U.S.C. 103(a) as being unpatentable over Burkinshaw (U.S. Patent 6,290,704).

Regarding claim 24, Burkinshaw discloses a device comprising a body having a bottom surface and a moveable cradle assembly. The moveable cradle assembly includes a cross-member and a plurality of shafts slidably coupling the cross-member to the body and a stylus operatively coupled to the cross-member (see Figure 1 below). Burkinshaw discloses the device further comprising a plurality of positionable drill guides coupled to the body. Regarding claim 25, Burkinshaw discloses a device wherein the drill guides are capable of being used for providing a femur post hole. Regarding claim 26, Burkinshaw discloses a device wherein the drill guides are

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positioned on a moveable body that is positioned within a recess in a top surface of the device body. Regarding claim 33, Burkinshaw discloses a device comprising a body having a bottom surface, a stylus having a tip, and means for moving the tip in a direction that is approximately perpendicular to a plane containing the bottom surface of the body, i.e. a sleeve, and a plurality of positionable drill guides coupled to the body. Further regarding claim 33, the applicant invoked U.S.C. 112 6<sup>th</sup> paragraph with a "means for" limitation in the claim. The examiner is required to reference the specification for the corresponding structure performing the function in the claim. The examiner believes the "means for" limitation is references in the specification on page 23 lines 2-8 regarding a sleeve. Therefore, the examiner will understand the "means for" language of claim 33 to reference a sleeve. Burkinshaw fails to disclose the device wherein the plurality of drill guides is separate elements capable of being positioned independently. It would have been obvious to one having ordinary skill in the art at the time the invention was made to manufacture the device of Burkinshaw wherein the plurality of drill guides are separate elements separate elements capable of being positioned independently , since it has been held that constructing a formerly integral structure in various elements involves only routine skill in the art. *Nerwin v. Erlichman*, 168 USPQ 177, 179.

Regarding claim 57, Burkinshaw discloses a device inherently capable of being used by a method comprising the steps of making an incision in a patient's knee, attaching a femoral implant drill guide to a prepared surface of a femur of the patient, wherein the drill guide includes a plurality of individually positionable femur post hole

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drill guides, individually positioning at least one of the femur post hole drill guides at a desired location, and drilling femur post holes in the femur through the individually positioned post hole guides. Regarding claim 52, Burkinshaw discloses a device inherently capable of being used by a method as discussed above wherein the femoral implant drill guide further comprises a sizing guide having a body with a bottom surface and a moveable stylus with a tip, wherein after the drill guide is attached to the prepared surface of the femur the method further comprises the steps of moving the tip of the stylus in both a direction that is approximately perpendicular to a plane containing the bottom surface of the sizing guide and in a direction that is approximately parallel to the plane containing the bottom surface of the body to position the tip of the stylus at a location proximate an anterior cortex region of the femur, and determining a size of the femoral knee prosthesis to be positioned on the femur. Regarding claim 56, Burkinshaw discloses a device as discussed above inherently capable of being used by a method discussed above further comprising the steps of moving a cross-member relative to the body to thereby move the tip of the stylus in a direction that is approximately parallel to a plane containing the bottom surface of the body to position the tip of the stylus at a location proximate an anterior cortex of the femur, and determining a size of a femoral knee prosthesis to be positioned on the femur. Regarding claim 58, Burkinshaw discloses a device inherently capable of being used by a method as discussed above wherein each of the individually positionable femur post hole guides is positionable for locating the femur post holes at a neutral or a three degree external rotation position. Regarding claim 59, Burkinshaw disclose a device inherently capable of being used by

a method as discussed above wherein both of the individually positionable femur post hole guides are positioned at a desired location.

***Allowable Subject Matter***

6. Claims 34-45 are allowed.

***Response to Arguments***

7. The applicant did not provide any arguments and placed all previously objected material into independent form as per the previous office action. The examiner has withdrawn the previously indicated allowability of claims 24-26, 33, 52, and 56-59 and presented new grounds of rejection above. The new grounds of rejection were not necessitated by amendment and the examiner has withdrawn previously indicated allowability of claims making this office action non-final.

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nicholas Woodall whose telephone number is 571-272-5204. The examiner can normally be reached on Monday to Friday 8:00 to 5:30 EST..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eduardo Robert can be reached on 571-272-4719. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only.

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NWWW



EDUARDO C. ROBERT  
SUPERVISORY PATENT EXAMINER